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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,236	07/13/2000	HIRAKU INOUE	450106-02185	9826
20999	7590	01/11/2006		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER WINDER, PATRICE L	
			ART UNIT 2145	PAPER NUMBER

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/600,236	Applicant(s) INOUE, HIRAKU	
	Examiner Patrice Winder	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,28-30,32-35,41,42,44-53,55-60,77-79,81-84,90,91 and 93-98 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>continuation sheet</u> . |

Continuation of Disposition of Claims: Claims pending in the application are 1-4,6-11,28-30,32-35,41,42,44-53,55-60,77-79,81-84,90,91 and 93-98.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on October 19, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USPN 6,910,086 has been reviewed and is NOT accepted.

The application/patent being disclaimed has not been identified.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 28, 41, 50, 77, 90 are rejected on the ground of nonstatutory double patenting over claim 7 of U. S. Patent No. 6,910,086 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: target devices, first reserve command and second reserve command.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 6-11, 28-30, 32-35, 41-42, 44-53, 55-60, 77-79, 81-84, 90-91, 93-98 rejected under 35 U.S.C. 103(a) as being unpatentable over Carson et al., USPN 5,887, 194 (hereafter referred to as Carson), in view of Stahl et al. USPN 6,665,020 (referred to Stahl).

7. Regarding claims 1 and 6, Carson discloses an information processing system, having a plurality of information processing apparatuses connected via a data bus corresponding to a predetermined communication format, for performing remote control of data and various commands transmitted and received between the information processing apparatuses, comprising,

a first information processing apparatus (i.e. processor (10), Carson, column 5, lines 4-18); and

a second information processing apparatus comprising: data recording and reproducing means for reproducing data from a predetermined record medium, recording data thereto, or editing data recorded thereon (i.e. audio/video option, (Carson, column 5, lines 30-57),

wherein the first information processing apparatus comprises: operation information transmitting means for transmitting an operation control command to the second information processing apparatus, the operation control command causing a remote control of a predetermined operation of the data recording and reproducing means of reserve request command transmitting means for generating a reserve

request command for requesting the first information processing apparatus for a reservation of a remote control against the second information processing apparatus and transmitting the reserve request command to the second information processing apparatus (i.e. lock, Carson, column 7, lines 37-65), and

wherein the second information processing apparatus comprises: receiving means for receiving data transmitted via the data bus, response processing for executing a predetermined process corresponding to one of various means commands received by the receiving means so as to enable another information processing apparatus to perform a remote control of the second information processing apparatus: local operation controlling means for locally performing an operation control for a predetermined operation against the data recording and reproducing means (audio/video option, Carson, column 7, lines 42-59 and column 13, line 63 - column 14, line 21),

first reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the receiving means, the response processing means so as to permit a remote control by the first information processing apparatus and prohibit a remote control by other information processing apparatuses (i.e. lock, Carson, column 16, lines 4-60).

Carson does not disclose a second reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the receiving means, the local information controlling means so as to enable a predetermine operation of those performed by the local operation controlling means and disable other

than the enabled operations. However, Stahl, in the same field of peripheral remote control endeavor, does disclose a second reserve mode setting means for setting, as a reserve mode to be set corresponding to the reserve request command received by the receiving means, the local information controlling means so as to enable a predetermined operation of those performed by the local operation controlling means and disable non-enabled operations (i.e. locking physical controls on device, Stahl, column 2, lines 19-37 and column 11, lines 17-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a second reserve function, disclosed by Stahl, into the remote controller, disclosed by Carson, in order to control a consumer electronic device from one remote control instead of its front panel.

Stahl further discloses reserve cancellation request command transmitting means for generating a reserve cancellation request command for requesting the second information processing apparatus for a cancellation of the reservation of the remote control and transmitting the reserve cancellation request command thereto, wherein the first reserve mode setting means of the second information processing apparatus causes the response processing means to permit all the other information processing apparatuses, connected to the data bus to perform a remote control of the second information processing apparatus corresponding to the reserve cancellation request command received by the receiving means so as to cancel the reserve mode, and wherein the second reserve mode setting means of the second information processing apparatus enables all the operations of the local operation controlling means

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corresponding to the reserve cancellation request command received by the receiving means so as to cancel the reserve mode, wherein the reserve cancellation request command transmitting means transmits the reserve cancellation request command when the operation information transmitting means is deactivated (Stahl, column 10, line 49 - column 11, line 16).

8. Regarding claim 2, Carson-Stahl further discloses the data bus corresponding to the predetermined communication format is an IEEE-1394 bus (Carson, column 5, lines 4-18) (Stahl, col. 3, lines 55-67).

9. Regarding claim 3, Carson-Stahl further discloses the second reserve mode setting means of the second information processing apparatus sets the reserve mode to the local operation controlling means so as to enable at least one of a record or reproduction stop operation, an eject operation for the record medium, and reproduction operations (Carson, column 7, lines 37-59) (Stahl, column 7, lines 39-67).

10. Regarding claim 4, Carson-Stahl further discloses the reserve request command transmitting means of the first information processing apparatus transmits the reserve request command when the operation information transmitting means is activated and operated (Carson, column 16, lines 4-60) (Stahl, column 11, lines 17-47).

11. Regarding claim 7, Carson-Stahl further discloses the second information processing apparatus comprises: bus reset detecting means for detecting an occurrence of a bus reset on the data bus, and wherein when the bus reset detecting means has detected an occurrence of a bus reset, the first reserve mode setting means causes the response processing means to permit all the other information processing

apparatuses collected to the data bus to perform a remote control of the second information processing apparatus so as to cancel the reserve mode and the second reserve mode setting means enables all the operations of the local operation controlling means so as to cancel the reserve mode (Carson, column 11, line 26 - column 12, line 24) (Stahl, column 10, lines 49-67, column 11, lines 1-16, 39-52).

12. Regarding claim 8, Carson-Stahl further discloses the second information processing apparatus further comprises: rejection response transmitting means for transmitting a rejection response to the first information processing apparatus, the rejection response representing the rejection of the reservation of the remote control, when the operation state of the second information processing apparatus prohibits the reservation of the remote control by the first information processing apparatus as a response to the reserve request command received by the receiving means (Carson, column 11, line 26 - column 12, line 24) (Stahl, column 10, line 49 - column 11, line 16).

13. Regarding claim 9, Carson-Stahl further discloses the reservation of the remote control by the first information processing apparatus is prohibited when the remote control of the second information processing apparatus is reserved by other than the first information processing apparatus (Carson, column 16, lines 4-60) (Stahl, column 11, lines 17-47).

14. Regarding claim 10, Carson-Stahl further discloses the reservation of the remote control by the first information processing apparatus is prohibited when an operation control for the editing processing is being performed by the local operation controlling

means of the second information processing apparatus (Carson, column 16, lines 4-60) (Stahl, column 11, lines 17-47).

15. Regarding claim 11, Carson-Stahl further discloses the first information processing apparatus further comprises: receiving means for receiving a rejection response transmitted from the second processing apparatus, the rejection response representing a rejection of the reserve request for the remote control by the first information processing apparatus, and presentation means for presenting that the remote control of the second information processing apparatus is prohibited, when the rejection response is received by the receiving means (Carson, column 11, line 26 - column 12, line 24) (Stahl, column 10, line 49 - column 11, line 16).

16. Regarding claims 28-30, 32-35, 41-42, 44-53, 55-60, 77-79, 81-84, 90-91, and 93-98, claims 28-30, 32-35, 41-42, 44-53, 55-60, 77-79, 81-84, 90-91, 93-98 have similar limitations as claims 1-11. Therefore, the similar limitations are disclosed under Carson-Stahl for the same reasons set forth in the rejection of claims 1-11.

Response to Arguments

17. Applicant's arguments filed October 19, 2005 have been fully considered but they are not persuasive.

18. Applicant argues – "Specifically. Applicant submits that there is no teaching or suggestion of a first information processing apparatus also having reserve cancellation request command transmitting means for generating a reserve cancellation request command for requesting said second information processing apparatus for a

cancellation of the reservation of the remote control and transmitting the reserve cancellation request command.”

- a. Stahl clearly taught “cancellation of the reservation of the remote control” through the dissolving of locks and by command in column 11, lines 39-53. The command is made by a first “information processing apparatus” and associated with a second “information processing apparatus” as required by applicant’s claim language.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Patrice Winder".

Patrice Winder
Primary Examiner
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January 7, 2006